

REMARKS

Status of the Claims

Upon entry of the instant amendment, claims 1, 4-9, 11-13, and 18-33 will remain pending in the above-identified application and stand ready for further action on the merits.

In this Amendment, claims 1, 4-9, 11-13, 20-29 and 31-32 have been amended. For example, claim 1 has been amended by incorporating the feature of claim 10. Claim 10 has been canceled without prejudice or disclaimer of the subject matter contained therein. Claim 11, which contains allowable subject matter, is rewritten in independent form as new claim 33.

Accordingly, the present amendments to the claims do not introduce new matter into the application as originally filed. As such entry of the instant amendment and favorable action on the merits is earnestly solicited at present.

Claim Rejections under 35 U.S.C. § 103

Claims 1, 4-10, 12-13 and 18-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hubinette et al. US '885 (US 7,628,885) in view of Rohlf et al. US '040 (US 6,489,040). This rejection is respectfully traversed.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the rejection and allow the currently pending claims.

Nonobviousness over the Combination of the Cited References

The primary reference Hubinette et al. US '885 relates to an uncoated paperboard with "a superior resistance against water penetration" in steam sterilization. The board is sized with a hydrophobic size such as AKD or ASA and alum to reduce water penetration through the cut

board edges (edge-wicking). However, Hubinette et al. US '885 fails to disclose or use of the claimed wet-strength size, as acknowledged in the Office Action.

Further, the gypsum wall board as disclosed in the secondary reference Rohlf et al. US '040 is totally irrelevant to the claimed invention, which is an autoclaved product package or a method thereof.

In this regard, it is alleged in the Office Action that these references are "analogous art" and the claimed invention is obvious over the combination thereof.

However, combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable to one of ordinary skill in the art. *United States v. Adams*, 383 U.S. 39, 51-52, 148 USPQ 479, 483-84 (1966). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.

The gypsum wall board of Rohlf et al. US '040 is an article of construction technology, not a product package as recited in the claims. A gypsum board is not autoclaved. The heat treatment at 150-200 °F mentioned by the Examiner is for drying, not autoclaving which brings about a wetting problem instead. Rohlf et al. US '040 merely discloses that paper sheets covering the gypsum board are sized with a specific combination of sizing agents for resistance to delamination (see, e.g., column 3, lines 53-65 of Rohlf et al. US '040). Rohlf et al. US '040 is silent about prevention of the raw-edge penetration in autoclave conditions. Thus, Rohlf et al. US '040 does not provide one skilled in the art with any solution to the raw edge soaking problem caused by hot pressurized steam used for autoclaving. Therefore, there is no rationale

and/or reasonable expectation of success for one skilled in the art to arrive at the claimed invention based on Hubinette et al. US '885 in combination of Rohlf et al. US '040.

Furthermore, in this Amendment, claim 1 has been amended by incorporating the feature of previous claim 10 (*i.e.*, "*the layer for reduced water penetration of the packaging material comprises a polymer coating*"). Rohlf et al. US '040 fails to disclose or suggest the claimed polymer coating. Further, the board of Hubinette et al. US '885 is uncoated. Incidentally, although Hubinette et al. US '885 mentions conventional art regarding a plastic coating of board (see *e.g.*, column 2, lines 5-7), the teaching relates to protecting the board from liquid or wet food. Namely, in view of nature of the technology, the coating as mentioned in Hubinette et al. US '885 should be provided inside of the package. Thus, Hubinette et al. US '885 fails to disclose or suggest a polymer coating layer on the outside.

Therefore, there is not provided any rationale and/or reasonable expectation of success based on the combination of the cited references, by which one skilled in the art could arrive at the present invention as claimed, since the cited references fail to disclose or suggest each of the instantly claimed features, as explained above. Thus, it is submitted that the present invention is not obvious over Hubinette et al. US '885 in view of Rohlf et al. US '040.

Based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection.

Allowable Subject Matter

The Examiner states that claim 11 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In this amendment, claim 11 has been rewritten in independent form as new claim 33.

Conclusion

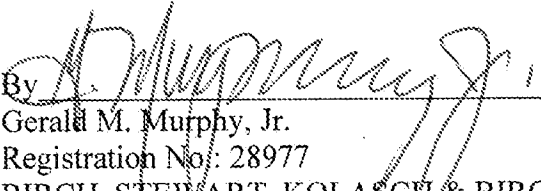
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims is allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Toyohiko Konno, Reg. No. L0053 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: APR - 5 2010

Respectfully submitted,

By 
Gerald M. Murphy, Jr.
Registration No.: 28977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747
703-205-8000